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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,526	04/12/2000	MARCEL AESCHLIMANN	41-303-3	4076

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EXAMINER

GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/38-526

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 16 SEPTEMBER 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 23-46 and 48-57 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 23-35, 48-50 and 54-57 is/are allowed.
- ☒ Claim(s) 36-46 and 51-53 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other REFERENCE COPY

Office Action Summary

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1. Before proceeding further, the following are noted with respect to pages 11-12 of the amendment: (a) Claim 36 line 2 - "in" should appear (i.e. have been inserted) after "attachment"; and (b) claim 37 line 6 - a (close or right) BRACKET should appear (i.e. have been inserted) after "fourth", both of the foregoing for the sake of accuracy and completeness.

2. Claims 36-46 and 51-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically (a) the last two steps in claim 36 and the last step in claim 37 are seen to involve and recite method or process limitations into what are intended to be article claims; it is felt that what is needed instead is a recitation and definition of the ultimate structure or construction of the bond or connection formed between the joining element and the part; (b) claim 37 line 6 - insert "being" before "disposed"; (c) line 1 of each of claims 38-46 should no longer recite or refer to a "joining element" in view of the amendment and restructuring of claim 37 e.g. for and in claim 38 line 1 - change "joining element" to "combination", and insert the term "joining element" after "said" instead, etc.; (d) claim 51 line 2 - insert the term "in said body" or "in said pin" after "opening", and change the term "an attachment" to "a head" or "a fitting" (consistent with page 9 lines 7-11 of applicants'

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specification); and (e) claim 52 line 2 - no antecedent basis for the term "said anchoring POINTS", only one such point being recited in claim 49.

3. Claim 53 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, there is seen to be no support or basis at all in the specification for the limitation in line 2 of this claim requiring the joining element to (further) comprise "a THERMOSETTING resin", the closest such disclosure apparently being found at page 4 lines 12-23, page 9 lines 22-26 and page 14 lines 10-19 of applicants' specification. This could be considered to be a new matter rejection. Further along this line, however, N.B. paragraph 25 of Corometrics v. Berkeley 193 USPQ 467.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 37 is further rejected under 35 U.S.C. § 102(b) as being (clearly) anticipated by Anderson.

Anderson discloses a combination (i.e. a composite bonded assembly or laminate) composed of a headed thermoplastic joining element body member and a thermoplastic part having a tapered socket aperture (i.e. bore) therein, the element and part being adhesively joined together via the COALESCENCE (i.e. FLOW, MIXING and uniting) of the respective thermoplastics of which they are formed, which COALESCENCE is effected by the application of (frictionally derived or generated) heat and pressure to the parts once they have been assembled and contacted such that the joining element is inserted into the bore of the part. (Figs. 1-2 and 4, column 1 lines 15-35, 41-46, 48-49 and 55-72, column 2 lines 1-39, column 3 lines 29-34). All of the essential limitations of this claim are seen to be satisfied by this reference.

6. In spite of the foregoing rejections, the Examiner continues to feel that there is patentable subject matter present in this application at this point in the prosecution, as follows: (a) Method claims 23-25 and article claims 48-50 and 54-57 appear to be allowable; and (b) the subject matter of article claims 36, 38-46 and 51-52 appears to be patentable also, all of the foregoing with the (1) caveat that yet another updated search may uncover art more pertinent than that already of record; and (2)

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proviso that the matters as set forth in paragraphs 2-3 above are satisfactorily resolved.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) ~~305-3599~~ ⁸⁷⁶⁻⁹³¹⁰.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.


JJGallagher:cdc

December 12, 2002


JOHN J. GALLAGHER
PRIMARY EXAMINER
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